



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,471	11/20/2003	Akemi Sanada		6874
24956 7590 03/26/2007 MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314			EXAMINER ADE, OGER GARCIA	
			ART UNIT 3627	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			03/26/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/716,471

Applicant(s)

SANADA ET AL.

Examiner

Garcia Ade

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 31-33 and 35-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-33 and 35-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed on November 30<sup>th</sup>, 2006 under 37 CFR 1.131 has been considered. Applicants amended claim 31, and cancelled claims 21 – 30, 34, and 39 – 43 without prejudice or disclaimer.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 31 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The added limitation "copying data stored in a first portion of the storage ....." is not supported in the specification.
4. Claims 32, 33, and 35 – 38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement based on their dependency on claim 31.

**Claim Rejections - 35 USC § 102**

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 31 – 33, 35 – 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Crawford [US 6,411,943].

**As per claims 31 and 32**, Crawford discloses a method for renting and charging for the use of the storage system comprising the steps of: providing the user with an initial volume of storage space of the storage system [see figure 1 (e.g. block 100 program storage, and figure 2 (e.g. block 210)]; charging the user for use of the initial volume at a predetermined rate [via Program & Information Rental Services (e.g. block 210), column 15, lines 39 – 44]; providing an added volume of storage space of the storage system as needed by the user [see flowchart of figure 8B (e.g. blocks 456 – 462 provide a generic description of **additional user request handling**)]; charging the user for a portion of the added volume that is actually used by the user [see claim 43 (e.g. **a portion of a mass storage device associated with the customer's computing device to the**

Art Unit: 3627

**service provider storage**), column 58, lines 44 – 54 (e.g. **storage usage charges assessed by the security programs into the Billing Data file** by matching Off-line Request begin and ending times)); the owner of the storage system is notified when the user begins using a portion of the added volume [see section IX (e.g. Request Pending Table Occurs, Request, Date/Time, Estimated Completion, **Notify Method**)]; and copying data stored in a first portion of the storage system into a second portion of the storage system and charging the user for the use of the second portion [see paragraph bridging column 21 and 22 (e.g., "COPY A:\*. \* C:" commands the computer to copy all files within a particular portion of a drive called "A" to a particular portion of another drive called "C"))].

**As per claims 33 and 36**, Crawford discloses information about the state of use of the storage system by the user is recorded in a management table [**Storage Charge Table 1010K**], and wherein the state of use information stored in the management table is used in order to determine how much the user is to be charged for renting the storage system [see flowchart of figure 10 (e.g. block 504, **on-line service control data table**)].

**As per claim 38**, Crawford discloses the step of: copying data stored in a first portion of the storage system into a second portion of the storage system and charging the user for the use of the second portion of the storage system at a rate lower than for use of the first portion of the storage system [see figure 2 (e.g. block 202, **virtual disk copy of the customer computer system disk**)].

Art Unit: 3627

**As per claims 35 and 37**, Crawford discloses the steps of: providing a display terminal to the user; and providing a display terminal to the owner; wherein both the user's display terminal and owner's display terminal are connected to the storage system via the internet so that both terminals can receive information regarding the state of use of the storage system by the user [see figure 3 (e.g. block 122, ***local display devices may be connected to host computer 104 to allow local control over the host computer***)].

### ***Response to Arguments***

7. Applicant's arguments filed on November 30<sup>th</sup>, 2006 have been fully considered but they are not persuasive.

Regarding the 102 rejection, Applicants argue that Crawford fails to disclose or suggest all of the limitations of amended claim 31. The Examiner respectfully disagrees. Crawford teaches an alternative embodiment, an Internet back-up system that provides services such as antiviral protection and other features including system storage where the user is often charged a fee based on the amount of time he is connected to the mainframe or the user is charged a fee for use of particular volumes in the storage system (see background and summary of the invention). In addition, Crawford discloses a computer automated access program can identify a lockup condition and break out of the task to continue with additional volume requests or upgrade by adding additional internal or external storage devices (see column 13, lines 39 – 59). Therefore, Applicants' arguments are deemed nonpersuasive.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Garcia Ade whose telephone number is 571.272.5586. The examiner can normally be reached on M-F 8:30AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian (Ryan) Zeender can be reached on 571.272.6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3627

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Garcia Ade  
Examiner  
Art Unit 3627

ga

*Andrew Joseph Rudy*  
Primary Examiner, AU 3627